

## REMARKS

Claims 1-35 are currently pending in the application; however, the final Office Action indicates that only claims 1-34 are pending. This error was noted in Applicant's response to the Office Action of 14 December 2004. Correction is again respectfully requested. Claims 1-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,014,644 to Erickson ("Erickson"). As the Office has not indicated that claim 35 stands rejected, Applicant respectfully asserts that claim 35 is in condition for allowance.

### Rejection Under 35 U.S.C. § 102(b):

As indicated above, claims 1-34 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Erickson. Independent claim 1 recites "a security module operable to **decrypt** the user documents" (emphasis added). Moreover, independent claim 1 requires "one or more **document** repositories operable to store a plurality of user **documents**" (emphasis added). Claim 1 is representative of independent claims 11 and 23. Accordingly, the remarks provided *infra* concerning independent claim 1 apply equally to claims 2-34.

In Applicant's response to the Office Action of 14 December 2004, Applicant asserts that Erickson fails to teach or suggest any system, method, or software operable to **decrypt** any document. In its final rejection, the Office relies upon Webster's Collegiate Dictionary to provide definitions for the term "decrypt." Applicant respectfully asserts that the Office has improperly construed the meaning of the term "decrypt" in light of the present Specification, as it would be interpreted by one of ordinary skill in the art.

In a recent decision, the U.S. Court of Appeals for the Federal Circuit expressly states:

The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim

language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art"<sup>1</sup>

(emphasis added). Moreover:

Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description"<sup>2</sup>

(emphasis added). The Court further instructs that "[t]he claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose."<sup>3</sup> Moreover, a claim "term can be defined only in a way that comports with the instrument as a whole."<sup>4</sup> "A fundamental rule of claim construction is that terms in a patent document are construed with the meaning with which they are presented in the patent document. Thus claims must be construed so as to be consistent with the specification, of which they are a part."<sup>5</sup> Furthermore:

Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.<sup>6</sup>

The Office has construed the term "decrypt" to mean "that when one has access to information on a database, the information is decrypted from a machine-readable format to a human-readable format."<sup>7</sup> The present Specification,

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<sup>1</sup> *Phillips v. AWH Corp.*, 03-1269, -1286, slip op. at 16 (Fed. Cir. July 12, 2005) (Fed. Cir. BBS), citing *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

<sup>2</sup> *Phillips*, slip op. at 16, citing 37 CFR § 1.75(d)(1).

<sup>3</sup> *Phillips*, slip op. at 15, citing *Network, LLC v. Centrall Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001).

<sup>4</sup> *Phillips*, slip op. at 15, citing *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996).

<sup>5</sup> *Phillips*, slip op. at 15, citing *Merck Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003).

<sup>6</sup> *Phillips*, slip op. at 15, citing *Renishaw*, 158 F.3d at 1250.

<sup>7</sup> Detailed Action, p. 3.

however, would not lead one of ordinary skill in the art at the time of the invention to such a definition. Rather, the present specification discloses:

The standard documents and unique documents may contain confidential or competitive information including, but not limited to, the names of the buyer 20 and seller 30 involved in the transaction, the product purchased, the quantity purchased, and the purchase price. Since the documents are stored in shared document repository 35 and seller databases 32 the documents will be accessible to other buyers 20 and sellers 30 through GCD 42, the confidential information of buyer 20 and seller 30 needs to be protected before the documents become freely available to the other buyers 20 and sellers 30. Therefore, security module 41 encrypts the standard documents and the unique documents (or portions of the documents, as described below) when the documents are stored in shared document repository 35 and seller database 32. The buyers 20 and sellers 30 with whom the documents are associated are each given the required permission level to decrypt the documents so that the associated buyer 20 and seller 30 can view the documents in their entirety with the confidential information. This allows a buyer 20 the ability to use GCD 42 to search and view all the documents where buyer 20 was a party, which therefore adds a document storage and review element to e-commerce transaction system 10. A buyer's or seller's own documents (when a buyer or seller is a party to a document) may be referred to as user documents. A buyer 20 or seller 30 typically has full access to their associated user documents. For example, buyer's 20a own documents are user documents for buyer 20a and buyer 20a has full access to all of the user documents of buyer 20a because buyer 20a is a party to all transactions from which the documents resulted. The user documents of buyer 20a are third party documents to all other buyers 20 because all the other buyers 20 were not a party to the transactions of buyer 20a. Therefore, each buyer 20 has their own user documents where they were a party to the transaction and that buyer 20 possesses the required permission level to access the user documents. But when a buyer 20 is not party to a transaction, any documents resulting from that transaction become third party documents to that buyer 20 and a buyer 20 does not have permission to access and view third party documents in their entirety.<sup>8</sup>

The ability of buyer 20 to view user documents increases the functionality of system 10 and adds a document storage and reuse element to system 10. But there needs to be a way for buyer 20 to store, access, and view user documents while concealing from other buyers 20 the confidential or competitive information contained in the user documents. When buyer 20 attempts to access and view user documents, security module 41 determines if buyer 20 has the required permission level to view the user

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<sup>8</sup> Specification, p. 26, ll. 3-31.

documents. In one embodiment, when security module 41 encrypts the documents, security module 41 may password protect each document and require the correct password to decrypt the documents. When buyer 20 makes a request to access user documents, security module 41 prompts buyer 20 for the correct password for decryption. Because the documents are the user documents for buyer 20, buyer 20 will have the required permission level and the correct password. When buyer 20 enters the correct password, buyer 20 has full access to the user documents in their entirety. Once buyer 20 has full access, buyer 20 may examine the user documents for previous purchase summaries to help with future orders or reuse and modify the user document for current transactions.<sup>9</sup>

FIGURES 6A & 6B illustrate an example method for storing, classifying, and reusing documents using GCD 42. The method begins at step 102 when security module 41 encrypts the documents to control access to the documents, protect any confidential or competitive information contained in the documents and therefore not allow a buyer 20 who was not a party to the transaction from which the document originated to access or view the confidential information in the document. When the documents are encrypted, a permission level is assigned to each encrypted document so that if a buyer 20 has the required permission level, that buyer 20 can decrypt the document and view the document in its entirety. A buyer 20 will be given the required permission level for all the documents in which that buyer 20 was a party to the transaction involving the document. Therefore, a buyer 20 will have the requested permission level to access and view in their entirety all the user documents for that buyer 20. GCD server 40 stores the documents in one or more document repositories at step 104. For example, GCD server 40 may store the standard documents in shared document repository 35 and the unique documents in one or more seller databases 32. In addition, a buyer 20 or seller 30 may only use standard document, may only use unique documents, or the document may not be differentiated as such and only stored as documents.<sup>10</sup>

If buyer 20 selects a user document at step 122, buyer 20 should possess the required permission level to decrypt the user document because a user document by definition is buyer's 20 own document and therefore buyer 20 has the required permission level. At step 132, security module 41 acquires the required decryption password or other information from buyer 20 and decrypts the document. At step 134 buyer 20 decides if buyer 20 wants to reissue the user document for a current transaction or simply view the user document. If buyer 20 decides to view the user document, then at step 136 buyer 20 views the user document from a previous transaction. Buyer 20 will typically view a user document to gather information about previous transactions, to study order history, determine

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<sup>9</sup> Specification, p. 27, ll. 15-30.

<sup>10</sup> Specification, p. 31, l. 17, through p. 32, l. 2.

when to initiate the next transaction, or for any other appropriate reason for viewing the user document. By viewing the user document, buyer 20 may see when the previous orders were placed, what where the terms and conditions associated with the previous orders, and when is the ideal time to initiate the next transaction.<sup>11</sup>

Emphasis added.

Applicant respectfully asserts that his Specification would lead one of ordinary skill in the art to appreciate that, at very least, documents are encrypted so that only those who should have access to the documents can read the decrypted documents. The documents may be decrypted using a password. The Specification reinforces Applicant's assertion, in that all documents are stored in shared document repository 35 and, if they were not encrypted and decrypted for authorized user access, a user could access documents that did not concern that particular user. Using the Office's definition for the term "decrypt" would allow a user to access documents that did not concern that particular user, contrary to the teachings of Applicant's Specification. The Office's definition of the term "decrypt" is counter to the teaching of the present Specification. Use of the Office's definition for the term "decrypt" construes the claimed limitation incorrectly and, thus, is improper. As asserted in Applicant's response to the Office Action of 14 December 2004, Applicant maintains that Erickson fails to teach or suggest any system, method, or software operable to **decrypt** any document. For at least this reason, the rejection of claims 1-34 is improper and should be withdrawn.

In Applicant's response to the Office Action of 14 December 2004, Applicant also asserts that Erickson fails to teach or suggest storing **documents** in one or more **document** repositories. In its final rejection, the Office again relies upon Webster's Collegiate Dictionary to provide definitions for the term "document." Applicant also respectfully asserts that the Office has improperly construed the meaning of the term "document" in light of the present Specification, as it would be interpreted by one of ordinary skill in the art.

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<sup>11</sup> Specification, p. 35, ll. 8-21.

The Office has construed the term "document" to mean "a writing that conveys information."<sup>12</sup> The present Specification, however, would not lead one of ordinary skill in the art at the time of the invention to such a definition. Rather, the present specification expressly discloses that the term "documents" "is meant to include documents created or used by a buyer 20 for a transaction and/or documents created or used by a seller 30 for a transaction."<sup>13</sup> Thus, one of ordinary skill in the art would appreciate that the terms "document" and "documents" in the claimed limitation "one or more document repositories operable to store a plurality of user documents", in the context of the present Specification, means a document or documents for a transaction. The Office's allegation that the term "document" means merely "a writing that conveys information" is counter to the teaching of the present Specification construes the claimed limitation incorrectly and, thus, is improper. As asserted in Applicant's response to the Office Action of 14 December 2004, Applicant maintains that Erickson fails to teach or suggest storing **documents** in one or more **document** repositories. For at least this additional reason, the rejection of claims 1-34 is improper and should be withdrawn.

Note that, while claim 35 is not included in the rejection over Erickson, claim 35 is allowable over Erickson for at least the same reasons set forth above concerning claims 1-34.

Therefore, it is respectfully requested that the rejection of claims 1-34 under 35 U.S.C. § 102(b), as being anticipated by Erickson, be reconsidered and withdrawn.

#### **The Legal Standard for Anticipation Rejections Under 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

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<sup>12</sup> Detailed Action, p. 3.

<sup>13</sup> Specification, p. 9, ll. 9-10.

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.

2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.

4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.

5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior

art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.

3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.

4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.

1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to



constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do

not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

## **CONCLUSION**

The Applicant submits that all of the Examiner's rejections are hereby traversed and overcome. The Applicant respectfully submits that the Examiner has not shown by clear and convincing evidence that the claimed invention would have

been anticipated by Erickson. For the reasons set forth herein, the Applicant submits that claims 1-35 are in condition for allowance, and respectfully requests that claims 1-35 be allowed.

No fees are deemed to be necessary; however, the undersigned hereby authorizes the Commissioner to charge any fees which may be required, or credit any overpayments, to Deposit Account No. **500777**. Should the balance in this deposit account be insufficient to fund the required fees, the undersigned hereby authorizes the Commissioner to alternatively charge any additional fees that may be required to Deposit Account No. **502806**.

**Please link this application to Customer Nos. 53184 and 38441 so that its status may be checked via the PAIR System.**

Respectfully submitted,

28 SEPT 2005

Date



James E. Walton, Reg. No. 47,245

Michael Alford, Reg. No. 48,707

Daren C. Davis, Reg. No. 38,425

Brian E. Harris, Reg. No. 48,383

Law Offices of James E. Walton, P.L.L.C.

1169 N. Burleson Blvd., Suite 107-328

Burleson, Texas 76028

(817) 447-9955 (voice)

(817) 447-9954 (facsimile)

jim@waltonpllc.com (e-mail)

**CUSTOMER NO. 38441**

**ATTORNEYS AND AGENTS FOR APPLICANT**